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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,360	02/19/2002	Mauro Costa	COSTA 8-8-5-7	8128

7590 11/22/2006

Docket Administrator Rm 3c 512
Lucent Technologies Inc
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EXAMINER

QURESHI, AFSAR M

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 11/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/069,360	Applicant(s) COSTA ET AL.	
	Examiner Afsar M. Qureshi	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This office action is responsive to Amendment After Final received on 10/25/2006.
2. Upon reviewing claims and drawings Examiner found some concerns over the clarity of claims and drawing as discussed below. As a result, the Examiner has withdrawn finality (Final Rejection dated 8/22/2006). New rejection follows.

Response to Arguments

3. Applicant's arguments in reference to Huusko (US 6,397,065) are persuasive. Examiner contends that the Berruto reference, **alone**, reads on the claimed invention. However, Huusko reference is used to discuss at least two core networks having different functionalities can switch packet transmissions based on terminal capabilities. Applicant argued that Berruto teaches separate 2G and 3G radio access networks for access to corresponding core networks. However, figure 5 (Berruto) clearly suggests enabling a dual mode terminal (GSM MSC ... 2G and GSM GPRS – SGSN... 3G) are in same location area. The Examiner believes that the rejection, dated 8/22/2006, still valid and clearly addresses all claim limitations.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The "...network *architecture*..." is vague. The "architecture" is not defined in the claim. Usually, it is the "*network comprising* : ..." followed by elements and functionalities associated with each element and utilities. Claim 1, which is a system/apparatus claim, has no elements, interworking and /or interoperability.

Similarly, the method claim 4 lacks elements performing certain method steps to achieve some kind of functionalities.

Drawings

4. Figure 3 is objected to under 37 CFR 1.83(a) because it fail to show the generic interface between the two system that comprises all of the necessary control and transport features needed for the claimed innovative solutions. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). The Examiner believes that Figure 3 is somewhat misleading. Applicant relies on GRAN concept for wireless access in UMTS'ISS - Schieder et al., (see Applicant's own admission in 'Summary of the Invention) wherein a generic interface to be specified between UMTS generic core network and GSM access

adaptation, GSM radio access part (for example, in Fig. 3, BSS 302 should have an interface to facilitate 2G services into 3G).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 rejected under 35 U.S.C. 103(a) as being unpatentable over Huusko (US 6,397,065) in view of "RESEARCH ACTIVITIES ON UMTS RADIO INTERFACE, NETWORK ARCHITECTURES, AND PLANNING (IEEE 1988) by Ermanno Berruto et al. [XP – 000740416] (hereinafter 'Berruto').

Consider claims 1, 2 and 4, Huusko discloses a network comprising a location area connected by a radio access network (column 1, lines 43-45) to at least two core networks having different functionality (column 1, line 43), wherein the radio access network switches packet transmissions from each terminal in the location area to one of at least two core networks (column 1, lines 57-60) characterized in that the radio access network switches packet transmissions from each terminal to one of the at least two core networks in dependent on the terminal's capabilities (column 1, lines 57-63). Huusko discloses various types of core network connected to a 3G radio access network, however, Huusko does not specifically discuss "connecting 2G radio access

network to 2G core network terminals that are not capable of connection to 3G radio access network,..." as added in the claims 1 and 4 via amendment.

Berruto, in the same field of endeavor, discloses a dual mode operation ((GSM-UMTS core networks in PSTN/ISDN) such that a terminal in the location area can be switched to one of the core networks depending on whether the terminal is of 2G capability or 3G capability therefore providing transition phase between 2G and 3G system deployment using GSM-BSS (see "Assumed Basic Network Architecture For the Radio Interface Definition" page 88, Figures 4 and 5).

Regarding claim 3, Huusko teaches a location updating method (column 3, line 24-28) in which the radio access network switches packet transmissions from each terminal to one of the at least two core networks in dependence on the identity of the cell in which the terminal is connected.

Therefore it would have been obvious to one of ordinary skill in the art, at the time of invention, to modify Huusko utilizing the radio access scheme and the GRAN approach, where single UMTS part able to connect with multiple core networks, taught by Berruto *called RAINBOW project) for an efficient global multimedia mobility.


6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

"Architectural Aspects for the Evolution of Mobile Communications Towards UMTS", Berruto, 1997 IEEE.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Afsar M. Qureshi whose telephone number is (571) 272 3178. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (571) 272 7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


AFSAR QURESHI
PRIMARY EXAMINER
11/16/2006